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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/751,489

12/28/2000

James A. Salomon

F-153

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7590

09/30/2004

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,489

Applicant(s)

SALOMON ET AL.

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Prosecution has been reopened in this application due to a remand from the Board of Appeals. The following new objection and 112 rejections have been added; the prior art rejection has not changed from the last Office action mailed on 5/16/03 and, therefore, are not repeated here.

Drawings

2. The drawings are objected to because Figures 5A-5D are said to be cross-sectional views of various embodiments of the invention, but the drawings do not show from where these sectional views are taken.

Additionally, Figure 1 is stated as being a diagrammatic representation illustrating the present invention and Figure 2 is stated as being a diagrammatic representation illustrating the side view of the invention. However, there are some inconsistencies between the two Figures.

In Figure 1, the lower belt 14 is shown to be extending beyond the upper belt 12 at both the upstream and downstream ends of the transport system 10. However, in Figure 2 the lower belt 14 is shown to be even with the upper belt 12 at the upstream end.

Also in Figure 2, there is tensioning roller 32 pressing down on the upper belt 12 causing the top portion of upper belt 12 to dip downwards, but in Figure 1 there is no roller 32 and the top portion of upper belt 12 is straight. Furthermore, in Figure 1 the rollers at the outermost ends of upper belt 12 appear to be at different heights. Specifically, roller 30 at the downstream end appears to be significantly higher than roller 22 at the upstream end. However, in Figure 1 the rollers at the outermost ends of the upper belt 12 appear to be shown at the same height.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: applicant has not clearly defined the term "mailpiece intake section" as used in claims 1, 9 and 11.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8, 11-18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 1, applicant recites, "an upper looping belt having a straight section with a predetermined width covering the printing area." However, Figures 1 and 5A-5D clearly show that the upper looping belt is adjacent to the print head 102 and does not cover the printing area at all. Due to these inconsistencies, one of ordinary skill in the art would not be able to understand and make or use applicant's invention.

Claim 11 has a similar problem.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8, 11-18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, applicant recites "a lower looping belt having a mailpiece intake section that extends beyond the width of the upper belt adjacent the printing area running from the upstream end towards the downstream end.

First, it is not clear which dimension applicant is referring to when he recites "the width of the upper belt." From the phrase, "adjacent the printing area" it appears that applicant is referring to the width of the upper belt 12 as shown in Figures 5A-5D (the width of the belt 12 being the dimension measured from left to right in these Figures). However, the phrase, "running from the upstream end towards the downstream end" would indicate that applicant intends the width to be the measurement of the belt 12 taken from Figure 2 (the width of the belt 12 being measured from left to right in this Figure). These two phrases appear to contradict one another, thus correction and/or clarification is required.

In addition, the recitation in claims 1, 9 and 11 requiring the mailpiece intake section and the straight section of the upper belt to form a wedge-shaped gap resulting in a soft ingest nip is inconsistent with the description in the specification (page 5) and drawing Figure 2 concerning both the straight section 24 and the ingest nip 40. Page 5 of the specification expressly describes the "straight section" 24 of upper belt 12 as being located "between the pulleys 26 and 28 running the length of the printing area 112," while Figure 2 shows the wedge-shaped gap and ingest nip 40 as clearly being located upstream from the straight section 24. Thus it appears that the wedge-shaped gap and resulting soft ingest nip 40 are formed by other portions of the upper and lower belts, and *not* by an portion of the straight section 24. Clarification and/or correction is required.

For the above mentioned reasons, the claims have been found indefinite.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 28, 2004


Daniel J. Colilla
Primary Examiner
Art Unit 2854